

REMARKS

Claims 32 and 35 have been amended. Claims 1-31, 33 and 34 have been canceled. Claims 36 - 39 have been added. Thus, claims 32 and 35 - 39 are now pending in the present application. No new matter has been added. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are in condition for allowance.

As per the telephone communication with the Examiner on December 8, 2008, new claims 36 - 39 have been added. The subject matter of canceled claims 29 - 31 has been incorporated into new claims 36 - 39. In view of the following remarks, it is respectfully submitted that new claims 37 - 39, which depend from claim 32, are in condition for allowance.

Claims 29 - 32 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,336,252 to Cohen.

The rejections of claims 29 - 31 which have been canceled will be discussed in regard to claim 32 and new dependent claims 36 - 39 which incorporate the canceled subject matter. It is respectfully submitted that Cohen fails to teach or suggest a method for removing a selected portion of tissue from a surface of a body cavity comprising the step of "*severing the selected portion of tissue from surrounding tissue; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body,*" as recited in claim 32. Rather, Cohen merely teaches a suction cup 92 adapted to be placed adjacent a target portion of the pericardium to permit the attachment of electrical leads thereupon. (See Cohen, col. 4, ll. 33 - 51; col. 5, ll. 27 - 58; col. 11, ll. 50 - 61). Nowhere in the disclosure does Cohen teach or suggest any method wherein any tissue is severed from a location adjacent the flexible cup 92. Rather, Cohen explicitly states the undesirability of such an embodiment as it would cause undue trauma to the heart. (See Cohen, col. 2, ll. 56 - 68).

It is therefore submitted that Cohen fails to teach or suggest "severing the selected portion of tissue from surrounding tissue; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body," as recited in claim 32 and that claim 32 is allowable over Cohen for at least this reason. Because claims 36 - 39 depend from and therefore include all of the limitations of claim 32, it is respectfully submitted that these claims are also allowable.

Claims 29 - 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,423,830 to Schneebaum et al. in view of Cohen.

The rejections of claims 29 - 31 which have been canceled will be discussed in regard to claim 32 and new dependent claims 36 - 39 which incorporate the subject matter thereof. It is respectfully submitted that Schneebaum fails to teach or suggest a step of “*visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup*” in combination with “severing the selected portion of tissue from surrounding tissue; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body,” as recited in claim 32. Rather, Schneebaum teaches a device wherein a web member 78 is ejected from a tubular member 57 “upon the detection of polyp PO via illumination outlet port 34 and imaging window 36.” (See Schneebaum, col. 5, ll. 23 - 28; col. 6, ll. 14 - 23; Figs. 5A - 5C). The imaging window of Schneebaum is located in the endoscope insertion member 60 separate from the polyp retrieval assembly 56 which houses the web member 78. (See Schneebaum, col. 6, ll. 5 - 23; Figs. 5A - 5C). Schneebaum does not teach and is incapable of positioning the web member 78 by observing tissue through the web member. It is therefore submitted that Schneebaum fail to teach or suggest the step of “visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup,” as recited in claim 32 and that claim 32 is allowable over Schneebaum.

Cohen fails to cure the aforementioned deficiency of Schneebaum. Specifically, Cohen also fails to teach or suggest a step of “*visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup*” in combination with “severing the selected portion of tissue from surrounding tissue; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body,” as recited in claim 32.

It is therefore respectfully submitted that Schneebaum and Cohen, taken either alone or in combination, fail to teach or suggest the steps of a step of “*visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup*” in combination with “severing the selected portion of tissue from surrounding tissue; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body,” as recited in claim 32 and that claim 32 is therefore allowable over Schneebaum and Cohen. Because claims 36 - 39 depend from and

therefore include all of the limitations of claim 32, it is respectfully submitted that these claims are also allowable.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneebaum in view of Cohen in further view of U.S. Patent No. 5,578,031 to Wilk et al. ("Wilk").

Amended claim 35 recites limitations substantially similar to claim 32, including a method for removing a selected portion of tissue from a surface of a body cavity, comprising the steps of "*visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup*" in combination with "*severing the selected portion of tissue from the surrounding tissue*, wherein the portions of tissue around the periphery of the selected portion of tissue are fastened together by stapling; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body." As noted above, Schneebaum and Cohen fail to teach this limitation. It is further submitted that Wilk fails to overcome this deficiency. It is therefore respectfully submitted that Schneebaum, Cohen and Wilk, taken either alone or in any combination, fail to teach or suggest the recited limitations of claim 35 and that claim 35 is therefore in condition for allowance.

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: December 12, 2008

By: 

Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel: (212) 619-6000
Fax: (212) 619-0276